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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/986,196 12/04/97 WESTERSON T 8757-009

HM22/0614

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1155 AVENUE OF THE AMERICAS
NEW YORK NY 10036-2711

EXAMINER

BRUSCA, J

ART UNIT

PAPER NUMBER

1631

DATE MAILED:

06/14/01

32

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

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Office Action Summary

Application No.

08/986,186

Applicant(s)

PETERSON ET AL.

Examiner

John S. Brusca

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 27-34,36-41,43-46 and 48-70 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 29,44-46,48-50,57-59,61-64 and 66-69 is/are allowed.
- 6) ☒ Claim(s) 27,28,36,43,60,65 and 70 is/are rejected.
- 7) ☒ Claim(s) 30-34,37-41 and 51-56 is/are objected to.
- 8) ☐ Claims ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 18) ☒ Interview Summary (PTO-413) Paper No(s) ____.
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: _____

DETAILED ACTION

1. This Office action is a non-final Office action due to new grounds of rejection under 35 U.S.C. § 103. The finality of the previous Office action mailed 3/17/00 is withdrawn.

Specification

2. The objection to the specification in the Office action mailed 3/17/00 is withdrawn in view of the paper copy of the sequence listing received 9/18/00.

3. The disclosure is objected to because of the following informalities:

The specification includes a table of contents that precede the first sentence of the specification. Since the Office practice is to consider the specification to begin with a first sentence consisting of the cross reference to related specifications, and the instant specification page 1 comes after the table of contents, the table of contents as filed will not be included in the patent if allowed. The objection would be overcome by filing an amendment that inserts the contents of the table of contents into page 1 after the first sentence of the specification. It is further requested that such an amendment include a deletion of the right hand side column that includes page numbers as the page numbers of the originally filed specification are not maintained during the publication process.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

4. The rejection of claims 34, 35, 41, 42, 45, 47, 49, and 50 under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention in the Office action mailed

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3/17/00 is withdrawn in view of the amendment received 4/18/01. It is noted that claim 48 should have been included in the above rejection but was omitted in the Office actions mailed 8/10/99 and 3/17/00 through Office error. The amendment to claim 48 received 4/18/01 obviates inclusion of claim 48 in the above rejection.

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Newly filed claims 60, 65, and 70 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention for reasons of record in the Office Action mailed 3/17/00.

Claim Rejections - 35 USC § 102

1. The rejection of claims 27-34, 36-41, 43-46, and 48-50 under 35 U.S.C. 102(f) because the applicant did not invent the claimed subject matter in the Office action mailed 3/17/00 is withdrawn in view of the arguments and evidence presented in the amendment received 9/18/00.

Claim Rejections - 35 USC § 103

7. It is brought to the applicants that the following rejections are based on prior art the qualifies under 102(e), and it is further noted that the rejection is based on claimed subject matter of the cited references.

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8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

10. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

11. Claims 27, 28, 36, and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,004,788.

The claims are drawn to a gene expression library comprising inserts derived from a plurality of species of organisms. In some embodiments the inserts of the library are derived from an environmental sample. In some embodiments the library is contained in host cells. In

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some embodiments the library comprises vectors derived from plasmids, phages, viruses, cosmid vectors, or artificial chromosomes.

U.S. Patent No. 6,004,788 claims in claims 1 and 2 an enzyme derived by a process of culturing host cells that comprise a library that comprises inserts derived from a plurality of species of organisms that may in some embodiments be derived from an environmental sample. U.S. Patent No. 6,004,788 shows in column 5, lines 52-59 that a variety of vector types may be used for the library claimed in U.S. Patent No. 6,004,788, including plasmids, phages, cosmids, and artificial chromosomes.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to make the library of instant claims 27, 28, 36, and 43 because U.S. Patent No. 6,004,788 claims in claims 1 and 2 an enzyme product made from the libraries of instant claims 27, 28, 36, and 43.

12. Claims 27, 28, 36, and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,958,672.

The claims are drawn to a gene expression library comprising inserts derived from a plurality of species of organisms. In some embodiments the inserts of the library are derived from an environmental sample. In some embodiments the library is contained in host cells. In some embodiments the library comprises vectors derived from plasmids, phages, viruses, cosmid vectors, or artificial chromosomes.

U.S. Patent No. 5,958,672 claims in claims 1, 5, 9, and 12 a method of identifying an enzyme derived by a process of culturing host cells that comprise a library that comprises inserts derived from a plurality of species of organisms that may in some embodiments be derived from

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an environmental sample. U.S. Patent No. 5,958,672 shows in column 4, lines 8-17 that the vector types used for the library claimed in U.S. Patent No. 5,958,672, may include phages and plasmids.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to make the library of instant claims 27, 28, 36, and 43 because U.S. Patent No. 5,958,672 claims in claims 1, 5, 9, and 12 a method of identifying an enzyme product made from the libraries of instant claims 27, 28, 36, and 43.

Allowable Subject Matter

13. Claims 29, 44-46, 48-50, 57-59, 61-64, and 66-69 are allowable.

14. Claims 30-34, 37-41, and 51-56 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

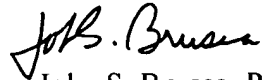
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John S. Brusca, Ph.D. whose telephone number is (703) 308-4231. The examiner can normally be reached on Monday -Friday 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael P. Woodward can be reached on (703) 308-4028. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-8724 for regular communications and (703) 308-8724 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.



John S. Brusca, Ph.D.

Primary Examiner

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jsb

May 12, 2001